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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,708	02/12/2004	James W. Voegelé	END-5017NP	5718

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EXAMINER

DAWSON, GLENN K

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/777,708	VOEGELE ET AL.	
	Examiner	Art Unit	
	Glenn K. Dawson	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03-15-05</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is directed to “the method of claim 4”, however, claim 4 is canceled. For the purposes of applying art, the examiner is treating claim 19 as being dependent on claim 16.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Meyers, et al.-5925064.

Meyers discloses a finger-tip actuated forceps having jaws 31,41 connected to u-shaped levers 30,42. When turned 90 degrees, the distal ends of the lever arms overlap. Attached to the lever arms is a means to attach the device to a finger. A spring

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is attached to bias the handles apart and the jaws together. In use, the device is placed into the body through an incision.

Claims 9,10,12,13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Blake-5944729.

Blake discloses a finger-tip actuated clamp having jaws attached to u-shaped lever arms. The lever arms are attached by a living hinge spring 28. The distal ends of the lever arms overlap each other. Line 48 could be the claimed fastening member.

Claims 9-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Schenk-4257406.

Schenk discloses a device having jaws attached to u-shaped lever arms. The distal ends of the arms overlap at 21. The proximal ends of the arms are attached by a rivet 13. The jaws are spring-biased closed.

Claims 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Redmon-5569300.

Redmon discloses a device having jaws attached to a u-shaped lever arms 13,14, at the proximal end of the arms are a spring 21,23 attached to the arms by fastening members 25.

Claims 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Mortier, et al.-6746471.

Mortier discloses a device having two jaws 75 attached to u-shaped lever arms with finger holes 72. At the ends are a fastening member 77 and spring 78.

Claims 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Saunders-5176696.

Saunders discloses a device having jaws 40,42 attached to u-shaped lever arms 24,34. Attached to the arms is a spring 62,64.

Claims 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Harrison-6146139.

Harrison discloses a device having jaws 24,25 attached to u-shaped lever arms 11,12,13. Element 13 is a living spring hinge which biases the jaws apart.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blake-'729 in view of Meyers, et al.-'064 and Sharpe-5222973.

Blake discloses the invention as claimed with the exception of the curved jaws, and the method of use. Meyers discloses curved jaws on finger-actuated surgical graspers. It would have been obvious to have used a curved jaw as this tends to be less traumatic to neighboring tissues. To have used the clamp of Blake by inserting it with the surgeon's hand through an incision would have been obvious as it provides greater control and is less traumatic than either a completely open procedure or one using a less sensitive clamp. Blake discloses that dissecting tissue is a delicate procedure and therefore it would have been obvious to have used the clamp of Blake for dissection of tissue, as it is sometimes necessary to dissect tissues around an artery that needs to be clamped. Sharpe discloses that it was known to use forceps to perform blunt dissection of tissues. It would have been obvious to have used a blunt surface of the end or side of the jaws to perform blunt dissection of tissues to minimize trauma to tissues needing to be separated from the surgical field.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyers, et al.-'064 in view of Sharpe-'973.

Meyers discloses the method as claimed with the exception of the device being used for dissection or blunt dissection of tissues. Sharpe teaches of using forceps to perform blunt dissection of tissues. It would have been obvious to have used a blunt surface of the end or side of the jaws to perform blunt dissection of tissues to minimize trauma to tissues needing to be separated from the surgical field.

Response to Arguments

Applicant's arguments with respect to claims 9-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Glenn K Dawson
Primary Examiner
Art Unit 3731

Gkd
07 September 2005